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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER SHIFERAW, ELENI A	
			ART UNIT 2136	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/897,480

Applicant(s)

MATSUURA ET AL.

Examiner

Eleni A. Shiferaw

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10,15-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10,15-19 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim status*

1. Claims 3, 9, 11-14, and 20 are previously canceled.
2. Claims 1-2, 4-8, 10, 15-19, and 21 are currently pending.

### *Response to Amendment*

3. The Examiner maintains the objections to the drawings because one ordinary skill in the art should be able to understand the Applicant's invention by looking at the drawings. However, applicant's drawings are missing legend. Appropriate correction is required in response to this office action.

### *Response to Arguments*

4. Applicant's amendments/arguments filed on 05/21/2007 have been fully considered but are not persuasive.

Regarding argument Yokono failure to disclose extracting the stored contents and encrypting the extracted contents, based on an identifier having been given uniquely to an optional medium prepared by the user and transmitted to the recording device in advance by the user, as recited in claim 21, remark page 12 par. 3, argument is not persuasive because col. 6 lines 43-61, and col. 7 lines 37-col. 8 lines 3, and col. 6 lines 11-15 of Yokono discloses a user purchasing a disk and registers the disk, **based on serial number/medium ID of the disk** and user identification, to download Contents to user's disk, with public downloading apparatus management company 2,

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and when user provides the disk to public downloading apparatus to have contents downloaded to the disk, the downloading apparatus I **checks the disk serial number** and user identification, then if check is okay the user is allowed to download user requested content that is provided from downloading apparatus management company 2 and stored in public downloading apparatus 1 and see col. 23 lines 8-col. 24 lines 65, and col. 17 lines 45-49 that further discloses public downloading apparatus extracting user requested content and enciphering the extracted content based on medium ID, user ID and password. Assuming the reference is not teaching encrypting using serial number, the argument does not place the application for allowance because as the office provided Sprunt on page 8 of the last office action, Sprunt discloses the well known argued subject matter on par. 0029 lines 27-29 wherein "encrypting ...using serial number...."

Regarding argument applied references failure to disclose wherein transmitting from a user an identifier having been given uniquely to an optional medium prepared by the user, as recited in claim 1, remark page 13, argument is not persuasive because: firstly, applied references disclose the argued limitation see Hollar col. 8 lines 5-13 where distribution server distributing content to users, that purchase a CD through a retail outlet rather than directly from the distribution server, and a retailer client transmitting its identification, the identification of the purchaser and the selection of content requested by the purchaser to the distribution server... and embeds watermark based on CD identifier see col. 6 lines 59-67. Secondly, assuming the references does not disclose the argued subject matter, this argument does not place the application for allowance because Yokono on page 7 or the last office action discloses a user purchasing a disk and

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registers the disk by sending serial number of the CD given uniquely to the CD to the public downloading apparatus, based on serial number/medium ID of the disk and user identification, to download Contents to user's disk, with public downloading apparatus management company 2, and when user provides the disk to public downloading apparatus to have contents downloaded to the disk, the downloading apparatus I checks the disk serial number and user identification, then if check is okay the user is allowed to download user requested content that is provided from downloading apparatus management company 2 and stored in public downloading apparatus 1 and see col. 23 lines 8-col. 24 lines 65, and col. 17 lines 45-49.

### ***Drawings***

5. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because figures 1 and 15 require **legend**. The applicant for the patent is required to furnish a drawing for his or her invention where necessary for the **clear understanding** of the subject matter sought to be patented. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Yokono et al. USPN 6,529,946 B2.

Regarding claim 21, Yokono et al. discloses a contents processing system for providing contents to a user, comprising:

a recording device including a processor capable of storing contents requested by the user in advance (col. 6 lines 43-61, and col. 7 lines 37-col. 8 lines 3, and col. 6 lines 11-15; *user purchases a disk and registers the disk, based on **serial number/medium ID** of the disk and user identification, to download contents to user's disk, with public downloading apparatus management company 2, and when user provides the disk to public downloading apparatus to have contents downloaded to the disk, the downloading apparatus 1 checks the disk serial number and user identification, then if check is okay the user is allowed to download user requested content that is provided from downloading apparatus management company 2 and stored in public downloading apparatus 1*), extracting the stored contents (col. 5 lines 10-col. 6 lines 61; *contents like daily electronic newspaper, news magazines, books, music are extracted from the contents server 4 and provided/stored into public downloading apparatus 1 to be extracted and recorded to users personal disk*) and encrypting the extracted contents, based on an identifier having been given uniquely to an optional medium prepared by the user and transmitted to the recording device in advance by the user (col. 23 lines 8-col. 24 lines 65, and col. 17 lines 45-49; *public downloading apparatus extracting user requested content and enciphering the extracted content based on medium ID, user ID and password*); and

an execution device including a processor capable of decrypting the contents recorded on the medium prepared by the user and reproducing, displaying or executing the contents recorded on the medium prepared by the user, based on the read identifier having been given uniquely to the medium prepared by the user (col. 23 lines 8-col. 24 lines 65, col. 29 lines 47-col. 54, and col. 10 lines 22-25; *deciphering contents recorded on the user disk*).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 7-8, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollar USPN 7,124,114 B1 in view of Spruit et al. US PG Pubs 2001/0030932 A1.

Regarding claim 1, Hollar discloses a contents processing method for providing contents to a user, comprising:

transmitting from a user an identifier having been given uniquely to an optional medium prepared by the user (col. 8 lines 5-13; *user transmitting unique CD identifier*);

storing contents as requested by the user in conjunction with the identifier transmitted by the transmitting in advance (col. 10 lines 35-67, and fig. 9 elements 903-904);

reading from the optional medium prepared by the user, the identifier having been given uniquely to the optional medium prepared by the user (col. 10 lines 35-54, col. 8 lines 5-13 and col. 7 lines 28-42; recipient identifier is read that is CD identifier/user's computer serial number);

extracting the stored contents, which have been stored in conjunction with the transmitted identifier, which is the same as the read identifier (col. 10 lines 52-62);

encrypting the extracted contents (col. 6 lines 59-67, and fig. 11; watermarking based on recipients identifier/CD identifier, and encrypted content);

recording the encrypted contents on the medium prepared by the user (fig. 7 and fig. 11);

accepting a limiting condition for reproducing, displaying or executing the contents by the user (col. 8 lines 15-28);

recording the accepted limiting condition on the medium prepared by the user (col. 8 lines 22-35 and fig. 7); and

reproducing, displaying or executing the contents recorded on the medium prepared by the user while decrypting the contents based on the identifier under the recorded limiting condition (col. 10 lines 35-67, col. 12 lines 63-67 and col. 13 lines 6-20).

Hollar embeds/watermarks based on CD identifier (see col. 6 lines 59-67) and also encrypts requested content based on usage information (see fig. 11). Hollar does not explicitly disclose encrypting based on the read identifier. However Sprunt discloses providing unique serial number to an optical disk and DVD at manufacturing and encrypting content data based on the unique serial number of the medium, by a content provider (see par. 0029 lines 27-29).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Sprunt within the system of Hollar because they are analogous in content distribution. One would have been motivated to incorporate the teachings of Hollar because it would identifier the key of the content encryptor based on serial number.



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Regarding claims 7 and 16, they are rejected under the same rational as claim 1 above.

Limitations of claims 7 and 16 are all disclosed in claim 21 above. In addition Hollar discloses the additional limitation of claims 7 and 16 wherein:

accepting fees for recording the contents on the medium (see claim 47 and col. 7 lines 43-56).

Regarding claims 8 and 18, all limitations of claims 8 and 18 are disclosed in claim 1 above and they have been rejected under the same rational as claim 1.

Regarding claims 10, 17, and 19, Holler discloses an execution device/medium for reproducing, displaying or executing contents to be provided to a user recorded on a medium, comprising:

a processor capable of performing the following operation:

reading an identifier having been given uniquely to an optional medium prepared by the user (col. 10 lines 35-54, col. 8 lines 5-13, and col. 7 lines 28-42; *CD/DVD identifier/recipient identifier/computer SN*);

accepting first specifying information for specifying the contents requested by a user (col. 8 lines 5-13, and lines 55-67);

accepting second specifying information for specifying other computer in which the contents are to be recorded (col. 8 lines 5-67, fig. 6 elements 607, 610/614, 601, and col. 10 lines 32-67);

transmitting the accepted first specifying information, second specifying information and the identifier read by the reading to an outside (col. 8 lines 5-13);

decrypting encrypted contents recorded on the medium prepared by the user (col. 10 lines 35-67), and stored in other computer in conjunction with the identifier transmitted by the transmitting, which is the same as the identifier of the medium (col. 10 lines 35-67, fig. 9 elements 903-904); and

reproducing, displaying or executing the decrypted contents under a limiting condition for reducing, displaying or executing the contents recorded on the medium prepared by the user (col. 10 lines 35-67, col. 12 lines 63-67, and col. 13 lines 6-20).

Hollar embeds/watermarks based on CD identifier (see col. 6 lines 59-67) and also encrypts requested content based on usage information (see fig. 11). Hollar does not explicitly disclose encrypting based on the read identifier and/or medium identifier. However Sprunt discloses providing unique serial number to an optical disk and DVD at manufacturing and encrypting content data based on the unique serial number of the medium, by a content provider (see par. 0029 lines 27-29).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Sprunt within the system of Hollar because they are analogous in content distribution. One would have been motivated to incorporate the

teachings of Hollar because it would identifier the key of the content encryptor based on serial number.

10. Claims 2, 4-6, and 15, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokono et al. USPN 6,529,946 B2 in view of Hollar USPN 7,124,114 B1.

Regarding claims 2 and 15, Yokono et al. discloses a contents processing system for providing contents to a user, comprising:

a central device connected to the recording device via a communication network (col. 7 lines 25-col. 8 lines 41 and fig. 1 elements 1, 2, 3, 4, 5, and 6);

the execution device includes a processor capable of performing the following operations:

reading an identifier having been given uniquely to an optional medium prepared by the user (col. 15 lines 11-66 and col. 18 lines 45; *medium ID/serial number of the disk is read by the public downloading apparatus 1 and/or public downloading apparatus management company 2*)

accepting first specifying information for specifying contents requested by the user (col. 14 lines 53-65 and col. 7 lines 55-col. 8 lines 3; *public downloading apparatus accepting first specifying info. Download ID/file name*);

accepting second specifying information for specifying a recording device in which the contents are to be recorded (col. 5 lines 10-col. 6 lines 61; *public downloading apparatus accepting second specifying info..... where content is updated from(public downloading*

*apparatus management company 2 address)...credit card company 3 address,.... where content is providing from(content company 4 address)...from users stored information on a disc.); and*

transmitting the accepted first specifying information, second specifying information and the identifier having been given uniquely to the medium prepared by the user to the central device (col. 5 lines 10-col. 7 lines 67; *public downloading apparatus 1 transmitting user stored info. from the disk to appropriate central server (Download ID to contents company 4, authenticator device name and update device name to credit card company 3, contents company 4, public downloading apparatus management company 2...))*);

the central device includes a processor capable of performing the following operations:

extracting contents from a content database storing contents, based on the transmitted first specifying information (col. 5 lines 10-col. 6 lines 61); and

transmitting the extracted contents and the transmitted identifier to a recording device corresponding to the transmitted second specifying information (col. 5 lines 10-col. 7 lines 67);

the recording device includes a processor capable of performing the following operations:

storing the transmitted contents in advance in conjunction with the transmitted identifier (col. 7 lines 37-col. 8 lines 3, and col. 6 lines 11-15; *user purchases a disk and registers the disk, based on **serial number/medium ID** of the disk and user identification, to download contents to user's disk, with public downloading apparatus management company 2, and when user provides the disk to public downloading apparatus to have contents downloaded to the disk, the downloading apparatus 1 checks the disk serial number and user identification **with stored**, then*

*if check is okay the user is allowed to download user requested content that is provided from downloading apparatus management company 2 and stored in public downloading apparatus 1 based on serial number);*

reading an identifier having been given uniquely to optional (fig. 13 *unique MEDIUM ID*) medium prepared by the user (col. 15 lines 11-66 and col. 18 lines 45; *medium ID/serial number of the disk is read by the public downloading apparatus 1 and/or public downloading apparatus management company 2*);

extracting the stored contents, which has been stored in conjunction with the transmitted identifier, which is the same as the read identifier (col. 5 lines 10-col. 6 lines 61, and col. 14 lines 53-65; *contents like daily electronic newspaper, news magazines, books, music are extracted from the contents server 4 and contents are stored based on request Download ID*);

encrypting the extracted contents, based on the read identifier (col. 23 lines 8-col. 24 lines 65, and col. 17 lines 45-49; *public downloading apparatus extracting user requested content and enciphering the extracted content based on medium ID, user ID and password*);

recording the encrypted contents on the medium prepared by the user (col. 17 lines 45-49; *recording encrypted user contents on users disk*);

accepting a limiting condition for reproducing, displaying or executing the contents by the user (col. 15 lines 64-col. 16 lines 66; *use record information public downloading apparatus 1 accepting starting and finishing time...date...month...year...hrs...min...seconds...*); and

recording the accepted limiting condition on the medium prepared by the user (fig. 8 and col. 15 lines 64-col. 16 lines 66; *recording use record info on the user's disk*),

the processor of the execution device is further capable of performing the following operation:

reading the identifier of the medium prepared by the user (col. 15 lines 11-66, col. 18 lines 45, and fig. 13; *reading medium ID/serial number of the user's disk*);

decrypting the contents recorded on the medium prepared by the user in an encrypted form, based on the read identifier (col. 23 lines 8-col. 24 lines 65, ; *deciphering contents recorded on the user disk*); and

reproducing, displaying or executing the decrypted contents under the limiting condition recorded on the medium prepared by the user (col. 29 lines 47-col. 54, and col. 10 lines 22-25).

Yokono et al. discloses a method of public downloading apparatus and the user approaches a public downloading apparatus with a user possession disk to download data from central content company 4. The user uses the public device the public downloading device to request and view content and does not explicitly disclose an execution device connected to a central device and recording device via a communication network. However, Hollar discloses the well-known remote user device (laptop or computer) connected to a central content device and recording device and the user transmitting required content name (col. 8 lines 5-13), user's CD(DVD) identifier/device number/identity (col. 8 lines 5-13; *user transmitting unique CD identifier*), and recording apparatus name information to the central device (col. 6 lines 23-65) and the central device transmitting the request information with the requested content to

identified recording apparatus and the recording apparatus first storing information in the system and recording to users device (col. 8 lines 5-67, fig. 6 elements 607, 610/614, 601, and col. 10 lines 32-67).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Hollar within the system of Yokono et al. because they are analogous in content recording. One would have been motivated to incorporate the teachings of Hollar because it is well known to request content remotely and provide content remotely.

Regarding claim 4, Yokono et al. further teaches the contents processing system/apparatus, wherein the contents are web pages, and the first specifying information is a search

searching for web pages, and the processor of the central device extracts a web page corresponding to the transmitted search keyword and web pages linked to the web page from the content database, based on the search keyword, for extraction of the contents (col. 6 lines 4-15; content server....electronic contents... and it is very well known at the time of the invention to search for web pages and extract a web page based on the user transmitted keyword please see Peinado et al. (Peinado, Patent No. US 6,772,340 B 1). One would have been motivated to modify the combination electronic information to web page because it would include web content to be provided to users.

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Regarding claim 5, Yokono et al. further teaches the contents processing system/apparatus, wherein the processor of the central device is further capable of performing an operation of accepting a limit number of times for limiting the number of times of linking between the web page corresponding to the search keyword and web pages linked to the web page, and the processor of the central device extracts the web page corresponding to the transmitted search keyword and web pages linked to the web page within the accepted limit number of times from the content database, based on the search keyword, for extraction of the contents (col. 6 lines 4-15; content server....electronic contents... and it is very well known at the time of the invention to search for web pages and extract a web page based on the user transmitted keyword please see Peinado et al. (Peinado, Patent No. US 6,772,340 B 1).

Regarding claim 6, Yokono et al. further teaches the contents processing system, wherein the processor of the execution device is further capable of performing an operation of transmitting a URL of a web page which is not stored on the medium prepared by the user to the central device when the web page is to be displayed on a browser (col. 6 lines 4-15; content server....electronic contents... and it is very well known at the time of the invention to search for web pages URL and extract a web page based on the user transmitted keyword please see Peinado et al. (Peinado, Patent No. US 6,772,340 B 1).

### ***Conclusion***



11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser R. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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